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FLYNN, THIEL, BOUTELL & TANIS, P.C. 2026 Rambling Road Kalamazoo, MI 49008-1699			EXAMINER SHOSHO, CALLIE E	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/973,646
Filing Date: October 09, 2001
Appellant(s): NISHIKAWA ET AL.

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Terryence Chapman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/27/05 appealing from the Office action mailed 12/1/04.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,364,422 B1	Sakaki et al.	4-2002
6,300,399 B1	Gallucci et al.	10-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1, 3-7, 12, 16-19, and 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Sakaki et al. (U.S. 6,364,422).

Sakaki et al. disclose composition comprising 2.5-8% thermoplastic elastomer including styrene-based elastomers such as hydrogenated polystyrene-polyisoprene block copolymer and hydrogenated polystyrene-polybutadiene block copolymer and 92-97% tungsten powder. There is also disclosed molded article comprising the above described thermoplastic elastomer and tungsten powder wherein the molded article has specific gravity greater than 8 and surface hardness less than 80 as measured by JIS K-7215 (col.3, lines 57-61, col.4, lines 27-42, col.5, lines 10 and 39-43, col.6, lines 7-15, and example 1). Although there is no disclosure in Sakaki et al. of at least one member selected from the group consisting of steel, brass, copper, etc., it is noted that the use of such member is optional in claims 22 and 23.

In light of the above, it is clear that Sakaki et al. anticipate the present claims.

2. Claims 1, 4-7, 16-19, and 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Gallucci et al. (U.S. 6,300,399).

Gallucci et al. disclose composition comprising 1-10% thermoplastic elastomer including styrene-based elastomers and 60-95% tungsten powder. There is also disclosed the use of additional fillers and reinforcements such as metal oxide and metal sulfates such as barium sulfate. There is also disclosed molded article comprising the above described thermoplastic elastomer and tungsten powder wherein the molded article has specific gravity greater than 3 (col.2, lines 28-32, col.3, lines 20-21 and 40-45, col.3, line 50-col.4, line 34 and 54-57, and col.5, lines 35-37 and 49-51).

Although there is no disclosure of the surface hardness of the molded article given that Gallucci et al. disclose molded article comprising identical amounts of thermoplastic elastomer and tungsten powder as presently claimed, it is clear that the molded article would inherently possess surface hardness as presently claimed.

With respect to claims 22 and 23 which each recite "consisting essentially of" transitional language, it is noted that Gallucci et al. require the use of polyester in addition to tungsten and styrene-based elastomer. However, while it is recognized that the phrase "consisting essentially of" narrows the scope of the claims to the specified materials and those which do not materially affect the basic and novel characteristics of the claimed invention, absent a clear indication of what the basic and novel characteristics are, "consisting essentially of" is construed as equivalent to "comprising". Further, the burden is on the applicant to show that the additional ingredients in

the prior art, i.e. polyester, would in fact be excluded from the claims and that such ingredients would materially change the characteristics of the applicant's invention. See MPEP 2111.03.

In light of the above, it is clear that Gallucci et al. anticipate the present claims.

3. Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gallucci et al. (U.S. 6,300,399) in view of Sakaki et al. (U.S. 6,364,422).

The disclosure with respect to Gallucci et al. in paragraph 3 above is incorporated here by reference.

The difference between Gallucci et al. and the present claimed invention is the requirement in the claims of specific type of thermoplastic elastomer.

Gallucci et al. disclose use of thermoplastic elastomers including styrene-based elastomers however, there is no disclosure of hydrogenated polystyrene-polybutadiene block copolymer as presently claimed.

Sakaki et al., which is drawn to composition comprising thermoplastic elastomer and tungsten powder, disclose the use of hydrogenated polystyrene-polybutadiene block copolymer as the thermoplastic elastomer in order to produce composition with good weather resistance and aging resistance (col.4, lines 18-42).

In light of the motivation for using specific thermoplastic elastomer disclosed by Sakaki et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use hydrogenated polystyrene-polybutadiene block copolymer as the thermoplastic elastomer in the composition of Gallucci et al. in order to produce composition with good weather resistance and aging resistance, and thereby arrive at the claimed invention.

4. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakaki et al. (U.S. 6,364,422) in view of Gallucci et al. (U.S. 6,300,399).

The disclosure with respect to Sakaki et al. in paragraph 1 above is incorporated here by reference.

The difference between Sakaki et al. and the present invention is the requirement in the claims of additional ingredient.

Gallucci et al., which is drawn to composition comprising styrene and tungsten as is Sakaki et al., disclose the use of additives such as metal oxides and metal sulfates such as barium sulfate in order to impart good mechanical properties and good processability to the composition (col.4, lines 47-57).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use metal oxide or metal sulfate in the composition of Sakaki et al. in order to produce composition with good mechanical properties and processability, and thereby arrive at the claimed invention.

(10) Response to Argument

(a) Appellants argue that Sakaki et al. is not a proper reference against the present claims given that the thermoplastic resin composition disclosed but not claimed in Sakaki et al. was invented by the inventors of the present application. Appellants argue that evidence to support this position is found in the two 1.132 declarations of record which state that the named

Art Unit: 1714

inventors in the present application invented the thermoplastic resin composition which is used to manufacture one of the elements of the balance weight claimed in Sakaki et al.

It is noted that Sakaki et al. names three co-inventors, Sakaki, Kadomaru, and Mizoguchi et al., two of which, namely, Sakaki and Mizoguchi are inventors of the present application.

In the first 1.132 declaration filed 10/14/03, three of the four co-inventors of the present application, namely, Sakaki, Mizoguchi, and Nishikawa et al., state that they are the true inventors of the thermoplastic resin composition of Sakaki et al. However, there was no disclosure regarding the fourth co-inventor of the present application, namely, Haruta. That is, there is no statement in the first 1.132 declaration that all of the inventors of the present application are the sole inventors of the subject matter in Sakaki et al.

The closest related case law to the present situation is *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982), however, the present situation appears to be a “reverse” *Katz* situation and thus, the fact pattern is different. That is, in *Katz*, the examiner cited a publication where applicant and two others were named as co-authors and applicant filed a 1.132 declaration to show that applicant was sole inventor of related subject matter disclosed in the publication. In the present application, which names 4 co-inventors, in response to examiner’s use of Sakaki et al. against the present claims which names 2 of the 4 inventors of the present application as co-authors, applicants must show that the third and fourth co-inventors of the present application are also co-inventors of Sakaki et al.

Although the fact pattern in *Katz* is different than in the present situation, it is noted that in *Katz*, applicant overcame rejections by stating in 1.132 declaration that he was the sole inventor of the subject matter described in the publication. However, in the 1.132 declaration

filed 10/14/03 in the present application, there is no such statement that all the inventors of the present application are the sole inventors of the subject matter in US 6,364,422. Of relevance to this situation is *Ex parte Magner, Long, Ellis, and Grinstead*, 33 USPQ 404 wherein a publication, by three of the four inventors of the instance application, was removed as a reference by such three inventors affidavit wherein not only did the inventors state that they were authors of the publication and that they were three of the four co-inventors of the invention claimed in the application, but also that the fourth co-inventor and themselves mutually participated in the conception, research, and reduction to practice of the claimed invention of the publication, and that the publication was prepared from research records of themselves and the fourth co-inventor. In the present declaration, there is no disclosure in the declaration regarding the fourth co-inventor of the present application, Haruta.

In response, appellants filed a second 1.132 declaration on 2/26/04 identical to that of the first declaration but signed by Mr. Haruta. However, it is noted that it is the examiner's position that the declarations of 10/14/03 and 2/26/04 are not successful in removing Sakaki et al. as a reference against the present claims for the following reasons.

Firstly, both declarations, i.e. the 10/14/03 declaration signed by Sakaki, Mizoguchi, and Nishikawa and the 2/26/04 declaration signed by Haruta, both state in the first line "We, the undersigned, hereby declare as follows:" and throughout the remainder of the declaration refer to "we" rather than the actual names of the inventors. The 10/14/03 declaration makes no reference to Haruta while the 2/26/04 reference makes no reference to Sakaki, Mizoguchi, and Nishikawa. Thus, there is no indication in either declaration that the "we" collectively refers to all four

inventors, i.e. Sakaki, Mizoguchi, Nishikawa, and Haruta, of the present invention. Rather, the 10/14/03 declaration states that Sakaki, Mizoguchi, and Nishikawa are the true inventors of Sakaki et al. (US 6,364,422) while the 2/26/04 declaration states that Haruta is the true inventor of Sakaki et al. There is no disclosure in either declaration that Sakaki, Mizoguchi, Nishikawa, and Haruta, the inventors of the present application, are the true inventors of the cited prior art Sakaki et al.

Appellants argue that since all four inventors signed the two declarations, it is clear that the “we” stated in the declarations collectively refers to all four of the present inventors.

However, given that there is no reference in the first 1.132 declaration to Haruta and no reference in the second 1.132 declaration to Sakaki, Mizoguchi, and Nishikawa, it is the examiner’s position that the declarations do not properly make clear that the “we” in each of the declarations collectively refers to all four of the present inventors.

Further, in response to the examiner’s position that the disclosure in the declarations is not a satisfactory showing as required under MPEP 716.10 but rather a conclusionary statement without supporting evidence, appellants point to MPEP 716.10 that states that an uncontradicted “unequivocal statement” from the applicant regarding the subject matter disclosed in an article, patent, or published application will be accepted as establishing inventorship.

However, it is also noted that MPEP 716.10 discloses that it is incumbent upon the inventors named in the application to provide a “satisfactory showing” under 37 CFR 1.132 that the inventorship of the application is correct, *In re Katz* 687 F.2d. 450, 455, 215 USPQ 14, 18 (CCPA 1982). In *Katz*, in response to a rejection utilizing a publication naming the inventor and

two co-authors, not only did the inventor of the application make a statement that he was the sole inventor of the subject matter described and claimed in his application and also that disclosed in the printed publication, but also provided an explanation that that the co-authors were students working under the direction and supervision of the inventor. There is no such similar explanation in the present declaration. There is no statement that Sakaki and Mizoguchi and Nishikawa and Haruta are the sole inventors of the subject matter described and claimed in his application and also that disclosed in the printed publication.

Thus, the declaration of 10/14/03 or the declaration of 2/26/04, either alone or in combination, does not provide a satisfactory showing to establish that the inventors of the present application are the sole inventors of the subject matter in Sakaki et al.

Further, there is confusion regarding lines 2-4 on page 2 of each of the 1.132 declarations. Specifically, this portion of the declaration states that the “entitled Balance Weight for Vehicle Wheel was invented independently by the inventors of U.S. Patent No. 6,364,422”. This statement appears to contradict the rest of the declaration. That is, the declaration is made to establish the inventors of the present application are the true inventors of Sakaki et al., i.e. US 6,364,422, however, by stating that US 6,364,422 was invented “independently” by the inventors of US 6,364,422, namely, Sakaki, Kadomaru, and Mizoguchi, it appears that the inventors of the present application are not the true inventors of US 6,364,422 which as disclosed by applicants was invented “independently” by Sakaki, Kadomaru, and Mizoguchi.

Appellants argue that this refers to the fact the present inventors invented the thermoplastic resin composition which was then used by the inventors of Sakaki et al. to make

the claimed balance weight. However, as set forth in MPEP 716.10 cited by appellants, it is noted that the 1.132 declaration must show that the inventorship of the application is correct in that the reference discloses subject matter derived from the applicant rather than invented by the author, patentee, or applicant of the published application notwithstanding the authorship of the article or the inventorship of the patent or published application, i.e. "a satisfactory showing that would lead to a reasonable conclusion that [applicant] is the...inventor" of the subject matter disclosed in the article and claimed in the application. However, by stating in each of the 1.132 declarations that Sakaki et al. was "invented independently" by the inventors of US 6,364,422, regardless of the appellants intent, such statement appears to suggest that the inventors of the present application are not the true inventors of US 6,364,422 which as disclosed by applicants was invented "independently" by Sakaki, Kadomaru, and Mizoguchi.

(b) Appellants filed 1.131 declaration on 5/27/04 to establish the reduction to practice of the present invention prior to the effective date of either Sakaki et al. or Gallucci et al.

The evidence set forth in the 1.132 declaration consists of a copy of JP 11-95712 as well a certified English translation of JP-95712.

It is noted that JP 11-95712 is a priority document to which appellants did not, i.e. see page 2 of the Oath/ Declaration filed 10/9/01, and can not, i.e. present application was filed more than 1 year after the filing date of JP 11-95712, claim priority.

Appellants agree that they cannot claim the benefit under 35 USC 119 of JP 11-95712, but argue that they can use JP 11-95712 to show that the invention of the present claims were actually reduced to practice prior to the effective filing date of Sakaki et al. or Gallucci et al.

However, it is the examiner's position that the 1.131 declaration submitted by applicants to establish reduction to practice of the present invention prior to the earliest US filing date of Sakaki et al. or Gallucci et al. is ineffective given that evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Sakaki et al. or Gallucci et al. reference to an actual reduction to practice.

Appellants are reminded that according to 37 CFR 1.131(b), applicants must establish reduction to practice prior to the earliest effective date of 8/27/99 of the Gallucci et al. and Sakaki et al. prior art references or conception of the invention coupled with due diligence from prior to the earliest effective date to a subsequent reduction to practice or to the filing of the invention.

Appellants argue that a 1.131 affidavit directed to a certified English translation of JP 11-95712 is evidence of reduction to practice. The examiner disagrees. It is the examiner's position that JP 11-95712 used by appellants shows conception not reduction to practice of his invention. To show constructive reduction to practice, the applicants' conception must be coupled with due diligence as set forth in 37 CFR 1.131(b) cited above.

Contrary to applicants' arguments, the certified English translation is not evidence of reduction to practice. Rather, it only serves to confirm evidence of conception of applicants' invention. There is no evidence of record which shows due diligence which is necessary along with conception to establish reduction to practice. That is, there is no data between the date of JP

Art Unit: 1714

11-95712 and the filing date of the US application that shows the required diligence. In fact, as it stands at present, applicants' constructive reduction to practice occurred on the filing date of his US application not before.

While not directed to the same fact pattern as in the present case, it is helpful to review the Court's decision in *In re Costello* 219 USPQ 389. In that case, the applicant filed a 1.131 affidavit arguing that filing of a parent application constituted reduction to practice for the continuing application even though the parent was abandoned prior to the filing of the continuation. In reversing the applicant, the Federal Circuit held that "The filing of the original application is, however, evidence of conception of the invention. Appellants were able to reduce the invention to writing. That writing therefore constitutes documentary evidence that appellants had conceived of the invention as of the filing date. As the board found, however, appellants did not establish diligence in reducing the invention to practice."

Given that the Federal Circuit did not find persuasive a 1.131 affidavit alleging reduction to practice as having occurred with the filing of the parent case where the applicant could not legitimately claim the benefit of the filing date of the parent case due to lack of diligence, the present situation in which applicant did not (and could not) claim foreign priority and cannot establish due diligence from the date of JP 11-95712 appears to be on even more solid grounds as regards refuting applicant's 1.131 affidavit alleging reduction to practice.

With respect to *Costello*, appellants argue that the present situation is different than that of *Costello* given that in *Costello* the Federal Circuit stated that an abandoned parent application, with which no subsequent application was co-pending, cannot be considered a constructive

reduction to practice but only as evidence of conception. Appellants argue that in the present situation, although appellants cannot claim the benefit of JP 11-95712 under 35 USC 119, this application was not abandoned by appellants and was pending as of the filing date of the present application.

However, pendency is not the issue with regards to JP 11-95712. Rather, the issue is that appellants did not rely on JP 11-95712 when filing the US application and thus, cannot rely on JP 11-95712 to establish reduction to practice of the present invention prior to the earliest effective date of the Gallucci et al. and Sakaki et al. prior art references.

Further, although the situation in *Costello* is not identical to the present situation, it is analogous.

That is, in *Costello*, the courts held that applicants could not rely on a parent application, abandoned prior to the effective date of a reference, as a constructive reduction to practice, given that the abandonment of the parent application resulted in an abandonment of the benefit of that filing as a constructive reduction to practice. While the courts noted that the filing of the original application is evidence of conception of the invention, the board found that the appellants did not establish diligence in reducing the invention to practice.

Analogously in the present situation, given that appellants did not and could not claim priority to JP 11-95712, appellants have “abandoned” the benefit of JP 11-95712 as a constructive reduction to practice. Thus, while in *Costello*, applicants lost the benefit of the parent application as a reduction to practice due to the “break” in continuity between the parent application and copending application, similarly, in the present situation, appellants have lost the benefit of JP 11-95712 as a reduction to practice due to the “break” between filing of JP 11-

95712 and filing of the present application, i.e. appellants filing of the present application was more than 1 year after the filing of JP 11-95712, such that appellants were unable to claim priority to JP 11-95712. While it is agreed that JP 11-95712 is evidence of the conception of the present invention, there is no evidence of record which shows due diligence which is necessary along with conception to establish reduction to practice. That is, there is no data between the date of JP 11-95712 and the filing date of the US application that shows the required diligence.

Appellants argue that they cannot find any US case law that states that, under the current rules which allow the establishment of a date of invention by acts carried out in a WTO member country, a foreign application cannot serve as a reduction to practice in a 37 CFR 1.131 affidavit.

However, while it is agreed that the date of invention can be established by acts carried out in a WTO member country and while neither agreeing or disagreeing with appellants statement regarding current US case law, it is noted that conversely, there is also no US case law that states that a foreign application to which appellants did not and could not claim priority can serve as a reduction to practice in a 37 CFR 1.131 affidavit. Based on the decision in *Costello*, it is clear that while JP 11-95712 is evidence of conception of the present invention, given the lack of diligence between this conception and the and the filing date of the US application, i.e. applicants did not claim priority to JP 11-95712, JP 11-95712 cannot establish reduction to practice of the present invention.

Appellants argue that the invention of claims 1, 3-7, and 12 were reduced to practice by at least April 2, 1999, which is prior to the filing date of Sakai et al. or Gallucci et al.

However, it is noted that Sakaki et al. and Gallucci et al. were each also used to reject claims 16-19 and 22-23.

With respect to claims 16-19 (and claims 22-23), it is noted that evidence submitted in the 1.131 declaration, namely, copy of JP 11-95712 and its English translation, is insufficient to establish reduction to practice of the invention prior to the effective date of either Sakaki et al. or Gallucci et al. given that the 1.131 declaration is not commensurate in scope with the scope of claim 16-19. That is, present claims 16-17 disclose additional component added to the thermoplastic resin composition while claim 18-19 disclose additional component added to the molded article. However, there is no disclosure in the 1.131 declaration of the reduction to practice of the thermoplastic resin composition or molded article that requires additional component as required in present claims 16-17 or 18-19. That is, there is no disclosure in JP 11-95712 of additional ingredient required in present claims 16-19. While JP 11-95712 discloses that the thermoplastic resin composition can contain conventional additives, this generic disclosure is very different than that of the recitation of specific metal oxides and sulfates. There is no evidence that the generically disclosed conventional additives of JP 11-95712 are the same as the specifically claimed metal oxides, metal sulfates, etc. and thus, the 1.131 declaration is not commensurate in scope with the scope of present claims 16-19.

(c) While it is appellants' position that Gallucci et al. is not available as prior art against the present claims in light of the 1.131 declaration filed 5/27/04, appellants also argue that even if Gallucci et al. were available as prior art, the present claims are distinguishable from Gallucci et al.

Specifically, appellants argue that Gallucci et al. does not anticipate the present claims under 35 USC 102 given that there is no specific disclosure in Gallucci et al. of a composition that falls within the scope of the present claims. Appellants argue that the impact modifier of Gallucci et al. is optional, i.e. "from 0 to 20 wt.% of an impact modifier", and that the use of styrene-containing polymer as the impact modifier is optional.

While it is agreed that there is no examples in Gallucci et al. that disclose the present claimed invention, however, "applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others", *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). A fair reading of the reference as a whole discloses the use of composition comprising about 5 to about 40 wt.% thermoplastic polyester, from about 60 to about 95 wt.% tungsten filler, and optionally from 1 to 10 wt.% of an impact modifier (col.2, lines 28-32). Thus, it is clear that in one embodiment, Gallucci et al. disclose composition comprising about 60 to about 95 wt.% tungsten which clearly overlaps the amount of tungsten presently claimed and 1-10% impact modifier. Further, while Gallucci et al. do disclose the use of impact modifiers other than styrene-based elastomers as presently claimed, it is noted that the choice of styrene-based elastomers is not from amongst a vast number of impact modifiers disclosed by Gallucci et al. but only from amongst a group of five, i.e. Gallucci et al. disclose the use of impact modifiers derived from the group consisting of olefins (i), vinyl aromatic monomers (ii) (corresponding to presently claimed styrene-based elastomers), acrylic and alkyl acrylic acids (iii) and their ester derivatives (iv) and conjugated dienes (v) (col.3, lines 54-57).

Appellants also argue that Gallucci et al. is not a relevant reference under 35 USC 103 in light of the comparative data set forth in the present specification.

The data compares composition within the scope of the present claims, i.e. comprising styrene-based elastomer and tungsten in amounts as presently claimed (examples 1-5), with composition outside the scope of the present claims, i.e. comprising amount of styrene-based elastomer and amount of tungsten each outside the scope of the present claims (comparative examples 1-3) and comprising thermoplastic elastomer outside the scope of the present claims (comparative example 4).

However, with respect to the anticipation rejection using Gallucci et al., as cited in MPEP 706.02(b), it is noted that a rejection based on 35 USC 102(e), can only be overcome by (a) persuasively arguing that the claims are patentably distinguishable from the prior art, (b) amending the claims to patentably distinguish over the prior art, (c) filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by "another". (d) filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, (e) perfecting a claim to priority under 35 U.S.C. 119(a)-(d) within the time period set in 37 CFR 1.55(a)(1) or filing a grantable petition under 37 CFR 1.55(c), or (f) perfecting priority under 35 U.S.C. 119(e) or 120. As can be seen comparative data is not sufficient to overcome an anticipatory rejection under 35 USC 102(e).

Even if Gallucci et al. were only applicable reference under 35 USC 103 as argued by appellants or with respect to the 35 USC 103 rejection of claims 3 and 12 utilizing Gallucci et al., it is noted that the data is not persuasive in establishing unexpected or surprising results over the cited prior art for the following reasons.

With respect to example 2, example 4, and example 5, it is noted that there is not proper side-by-side comparison between these compositions within the scope of the present claims and the comparative examples outside the scope of the present claims. That is, example 2 utilizes thermoplastic elastomer that is SEPTON 4033 and tungsten with average particle diameter of 13 μm . Thus, there is not proper side-by-side comparison with comparative examples 1 and 2 which each utilizes different thermoplastic elastomer and with comparative examples 2 and 3 that each utilizes tungsten having different average particle diameter. Thus, it is not clear when comparing example 2 with the comparative examples whether the differences are due to the amount of styrene-based elastomer and/or amount of tungsten or to the different elastomer utilized and/or the different average particle size of the tungsten. Similar analysis can be made with respect to example 4 wherein there is not proper side-by-side comparison with comparative examples 1 and 2 which each utilize different thermoplastic elastomer and tungsten having different average particle diameter and with comparative example 3 that utilizes tungsten having different average particle diameter and with respect to example 5 where there is not proper side-by-side comparison with comparative example 1-4 given that each discloses the use of tungsten with different average particle size.

Further, with respect to comparative example 4, there is no proper-side-by-side comparison between the inventive examples and comparative example 4 given that the data is not commensurate in scope with the scope of Gallucci et al. given that the scope of comparative example 4 is not only outside the scope of the present claims but outside the scope of Gallucci et al. that does not utilize Nylon 6.

In fact, the only proper side-by-side comparison that can be made, i.e. between composition comprising same type of thermoplastic elastomer and tungsten having same average particle size, is between example 1 and comparative example 1 and example 3 and comparative example 2.

However, comparative example 1 is not commensurate in scope with the scope of the prior art, namely, Gallucci et al., given that the comparative example is not only outside the scope of the present claims, but also outside the scope of Gallucci et al. The comparative example utilizes 98% tungsten while the upper limit of the amount of tungsten disclosed by Gallucci et al. is 95% and thus, comparative example 1 is outside the scope of Gallucci et al.

Further, when comparing example 3, i.e. comprising 14% styrene-based elastomer and 82% tungsten, with comparative example 2, i.e. 18% styrene-based elastomer and 82% tungsten, it is noted that comparative example 2 discloses amount of styrene-based elastomer and amount of tungsten outside the scope of the present claims. It is shown that the molded article produced from example 3 has specific gravity of 5 and surface hardness of 8 while the molded article of comparative example 2 has specific gravity of 4 and surface hardness of 5.

Appellants argue that the molded article of comparative example 2 cannot provide a sufficient specific gravity. However, the data is not persuasive given that there does not appear to be a significant difference between the molded article within the scope of the present claims, i.e. specific gravity of 4, and molded article outside the scope of the present claims, i.e. specific gravity of 5. Further, it is significant to note that present claim 5 requires hardness of the molded article of 80 or less while present claim 6 requires specific gravity of 8 or more. Thus, it appears that the surface hardness of comparative example 2 is within the scope of the present invention.

Art Unit: 1714

and that while the surface gravity of the comparative example 2 is outside the scope of the present invention, so is that of example 3.

In light of the above, it is the examiner's position that, contrary to appellants' arguments, the data set forth in the present specification is not successful in establishing unexpected or surprising results over the Gallucci et al.

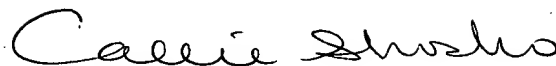
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Art Unit: 1714

Respectfully submitted,



Callie Shosho
Primary Examiner
AU 1714

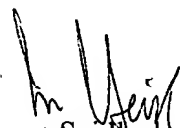
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3/27/06

Conferees:



Vasu Jagannathan



James Seidleck